

REMARKS

Applicant confirms the election of Group I, corresponding to Claims 1-17 and 21-23, in response to the restriction requirement imposed by the Examiner. Nonelected Claims 24-37 have been withdrawn.

Applicant further confirms that none of the claims have been rejected on art.

Claims 1-17 and 21-23 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 2-18 of U.S. Patent No. 6,134,207. In this regard, it is stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the broader limitations claimed in Claims 1-17 and 21-23 of the instant application are fully disclosed, encompassed and patented in Claims 2-18 of the '207 Patent.

A review of the file history of U.S. patent application Serial No. 09/135,236 filed August 17, 1998, which matured into the '207 Patent, reveals that in an Office Action mailed April 5, 1999 a restriction was imposed between Group I, corresponding to Claims 1-17 drawn to an optical microswitch, and Group II, corresponding to Claims 18-20 drawn to a magneto optical disk drive. In an Amendment and Response to Restriction Requirement mailed May 5, 1999, Claims 1-17 were amended to depend from Claim 18 and it was requested that the restriction requirement thus be withdrawn. In an Office Action mailed May 18, 1999, it was stated as follows: "The following action is taken: Amending the independent claims to read on an optical data storage system, the examiner agrees with applicant's arguments and all the claims are hereby prosecuted on the merits."

The referenced application was filed as a divisional application of the '236 Application. Claims 1-17 herein are directed to an optical microswitch. Claims 21-23 are directed to an optical microapparatus and Claims 24-37 are directed to a micromachined reflector. As noted above, Claims 24-37 have been withdrawn.

Applicants respectfully submit that the double patenting rejection over the '207 Patent should be withdrawn. In this regard, 35 U.S.C. §121 states:

"A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."

As can be seen, 35 U.S.C. §121 precludes the '207 Patent from being cited against the referenced divisional application.

Any argument by the Examiner that the double patenting rejection is proper because the restriction requirement was withdrawn by the examiner of the '236 Application is in error. Any withdrawal of the restriction requirement in the '236 Application was only as a result of the applicant's amendment of Claims 1-17 to depend from the elected Claims 18-20. Applicant was not permitted to pursue Claims 1-17, independently from Claims 18-20, because of the restriction requirement.

MPEP Section 804.01 sets forth several situations where the prohibition of double patenting rejections under 35 U.S.C. §121 does not apply. One of such situations, noted in MPEP Section 804.01(E), is where the requirement for restriction was withdrawn by the examiner before the patent issues. *In re Ziegler*, 443 F.2d. 1211, 170 USPQ 129 (CCPA 1971) is cited in support of this situation. But the facts of *In re Ziegler* are not analogous to those of the instant application.

In *In re Ziegler*, the examiner initially required restriction between certain catalyst claims and certain process claims. The applicants elected the process claims. Thereafter, the examiner notified the applicants that both the elected process claims and the non-elected catalyst claims were deemed allowable. The examiner later withdrew the restriction requirement, but the applicants nonetheless subsequently cancelled the process claims. Twice after such cancellation, the examiner warned the appellants of the possibility of a double patenting rejection in a later-filed application of the appellants. Applicants in both instances were given the opportunity to reinstate the process claims, but failed to do so. The court affirmed the decision of the Board of Appeals, which had previously affirmed the rejection of all claims in the later-filed application on the ground of double patenting.

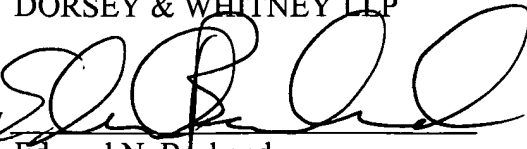
As can be seen, the applicants in *In re Ziegler* had the opportunity, after withdrawal of the restriction requirement, to pursue the nonelected claims. In the instant application, Applicants COULD NOT pursue the nonelected claims in the '236 Application. Any withdrawal of the restriction requirement in the '236 Application was because Applicants had amended the nonelected claims to depend from the elected claims, not because the examiner in the '236 Application decided to permit the prosecution of the nonelected claims in the '236 Application.

In view of the foregoing, Applicants request that the double patenting rejection be withdrawn and the application be passed to issue.

Respectfully submitted,

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